REMARKS

Claims 28-37 remain for prosecution in the present application.

Second Supplemental Information Disclosure Statement

Attention is directed to the Second Supplemental Information Disclosure Statement that accompanies this Amendment, including the Search Report and Written Opinion in the corresponding PCT application.

Friedman 5,992,657, cited in the PCT Search Report and Written Opinion, discloses a child-resistant tamper-indicating closure and package, with no suggestion whatsoever that the closure and/or the package can be or should be convertible to non-child-resistant operation. A tamper band 40 is frangibly connected by bridges 42 to the closure skirt 34 on the closure as made and initially applied to the container. A first lug 38 is integral with the closure skirt 34, and a second lug 48 is integral with the tamper band 40. After the closure has been applied to the container finish, first rotation of closure shell 30 in a removal direction ruptures the bridges 42, so that the tamper band 40 is severed from the closure skirt 34 and remains on the container to provide tamper indication (FIG. 4). However, to rotate the closure shell further toward removal, lug 48 on tamper band 40 must be deformed to allow passage of lug 38 on the closure shell (FIG. 5). The closure shell 30 can then be removed from the package (FIG. 6). Note, however, in FIG. 6 that the tamper band 40 and the lug 48 remain on the container finish, so that the package remains a child-resistant package after the closure shell 30 is re-applied to the container finish. It also is noted that, once the closure is applied to the container finish, there is no way to remove the entire closure, including tamper band 40, from the container finish so that the tamper band 40 can be removed from the closure while the closure is off of the container finish and the closure thereby made non-child resistant. In summary, this reference discloses the broad concept of providing a child-resistant element 48 on a frangible band 40, but does not disclose or suggest the subject matter of new claim 28, for example, whereby the band 40 can be removed from the closure, after the closure has been removed from the container finish, so that the closure and package are rendered non-child-resistant.

Hopley 4,345,690 discloses a child-resistant package in which a squeeze-and-turn band 5 is connected by bridges 4 to the skirt 2 of the closure. However, the bridges 4 are not frangible in the disclosed use and operation of the closure. The bridges 4 are spaced from each other to allow the band 5 to be ovalized upon squeezing so that the closure can be removed from the container.

Nixdorff 3,744,655 discloses a package that includes a ring 12 applied to the finish of a container separately from the closure 14. The ring 12 is not frangibly connected to the closure.

Claim Rejections - Prior Art

Claims 1-27 of the application as filed have been rejected as being either anticipated by Mathes 6,016,930, or obvious over Mathes combined with either Valyi 5,673,808 or Stahl 4,326,639. Original claims 1-27 have been replaced by new claims 28-37. Favorable reconsideration and allowance of these new claims are believed to be in order and are respectfully solicited.

Mathes discloses a child-resistant adapter band for converting a non-child-resistant closure into a child-resistant closure. That is, the adapter band (e.g. band 30 in

FIG. 1) is an element provided separately from an "existing" non-child-resistant closure shell 10 (column 1, lines 8-11, 36-39 and 46-49, column 1, line 65 to column 2, line 9, and column 2, lines 29-32). The adapter band 30 has an internal groove 38 that is received by snap-fit over the lip 16 on the closure skirt (column 4, lines 9-11). After such assembly onto the skirt, the adapter band can be secured to the closure shell "by any suitable means" to prevent rotation between the shell and the band, such as by thermal bonding, gluing, or provision of "suitable mechanical means" such as lugs 39 illustrated in FIG. 4 (column 4, lines 12-19). There is no suggestion whatsoever in Mathes that adapter band 30, once secured to the closure, could or should be removable from the closure to convert the closure to non-child-resistant operation.

Valyi and Stahl disclose closure shells having tamper-indicating bands integrally molded with the shells and frangibly connected to the skirts of the shells so as to be removed from the closure shell when the closure is first removed from the container finish. There is no disclosure or suggestion in either reference that the closure should be removable from the container finish with the tamper band intact, and indeed such would be contrary to the intended tamper-indicating function of the closure in each of these references.

New independent claim 28 of the present application is directed to a child-resistant package that includes a closure applied to a container. The container finish and the closure skirt have respective first and second engagement elements engagable with each other in a child-resistant mode of operation. The closure, including a portion of the skirt on which the second engagement element is disposed, includes a closure shell of one-piece integrally molded plastic construction that is selectively removable from the container. The portion of the skirt on which the second engagement element is disposed is selectively permanently removable from the closure shell, with the closure removed from the container, to remove the second engagement element from the closure and thereby permanently convert the closure for non-child-resistant mounting on the container.

The adapter band in Mathes is, of course, not of one-piece integrally molded construction with the closure shell, and indeed the entire purpose of Mathes is to provide a separate adapter ring for mounting on an "existing" non-child-resistant closure shell to adapt the shell for child-resistant operation. Furthermore, as noted above, there is no disclosure or suggestion in Mathes that the adapter ring, once mounted on the shell, could or should be permanently removable from the shell permanently to convert the closure for non-child-resistant mounting on the container. It is axiomatic that, in order to "anticipate" a claim, "all the elements in the claim (or possibly their equivalents...) must have been disclosed in a single prior art reference or device." *Radio Steel & Mfg. Co. v. MTD Products, Inc.*, 731 F.2d 840, 845, 221 U.S.P.Q. 657, 661 (Fed. Cir. 1984). "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindermann Maschinenfabrik v. American Hoist & Derrick*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1983) (emphasis added). "It is improper for an examiner to attempt to rebuild a reference . . ., in light of appellant's disclosure in order for it to operate in a manner never intended or contemplated" by the reference to support a rejection based upon alleged anticipation. *Ex parte Garrett*, 132 USPQ 514 (POBA 1961). Moreover, "it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (BPAI 1990). If anticipation is based upon alleged inherency, such alleged inherency must be certain, and cannot be established by probabilities or speculation. *Ex parte Cyba*, 155 U.S.P.Q. 756 (POBA 1967): *Ex parte Keither*, 154 U.S.P.Q. 320 (POBA 1967). Thus, Mathes clearly does not anticipate the invention of new claim 28.

The Examiner's proposed combination of Mathes with either Stahl or Valyi is not understood. Stahl and Valyi disclose typical tamper-indicating closures that have tamper bands frangibly connected to the closure skirt for permanent separation from the skirt when the closure is first removed from the container to indicate that the container has been opened. On the other hand, Mathes is for providing child resistance where the closure is initially non-child-resistant in construction. Furthermore, FIGS. 11-13 of Mathes disclose an adapter ring 230 having a tamper band 233 connected to the adapter ring. When the closure with adapter ring is first removed from the container neck finish, the tamper band is removed from the adapter ring to provide tamper indication. There is absolutely no basis in Mathes, Stahl or Valyi to suggest that the separate adapter ring disclosed in Mathes could somehow be frangibly connected to the closure shell, in view of Stahl, Valyi or otherwise.

It is axiomatic that, to support a rejection of the subject claims on the basis of obviousness, it is necessary that the references teach, suggest or provide incentive to combine elements from various references to obtain the invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686 (Fed. Cir. 1987); *Ex parte Clapp*, 227 USPQ 972 (POBA 1985). This is particularly true, of course, where the elements of the references would be required to coact with each other in a manner different from the way they coact in the reference disclosures, or where the key or distinguishing element of the claims is completely lacking in the references.

> [I]n order to meet the terms of the claims on appeal, the elements of the [prior art] device would have to be arranged in a manner different from that disclosed by [the art]. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide motivation or reason for the worker in the art, without the benefit if applicant's specification, to make the necessary changes in the reference device.

Ex parte Chicago Rawhide Mfg. Co, 223 USPQ 351, 353 (POBA 1984). See also *Fromsom v. Advanced Offset Plate, Inc.*, 755 F.2d 1549, 225 USPQ 26 (CAFC 1985); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (CAFC 1983) and *Ex parte Stauber*, 208 USPQ 945, 946 (POBA 1980).

> Simply stated:
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> It is wrong to use the [application] as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

Orthopaedic Equipment Co., Inc. v. U.S., 702 F.2d 1005, 217 USPQ 193, 199 (Fed. Cir. 1983).

> When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why combination of the reference teachings is proper.

Ex parte Skinner, 2 USPQ 2d 1788, 1790 (BPAI 1987). This the Examiner has not done in the present application.

Dependent claim 29 recites that the closure has a base wall and the container finish has an open end. The first engagement element on the container finish is spaced from the open end and the second engagement element on the closure skirt is spaced from the base wall. The finish includes a third engagement element between the first engagement element and the open end, and the closure includes a fourth engagement element between the second engagement element and the base wall for engagement with the third engagement element in the non-child-resistant mode of operation with the skirt portion removed from the closure skirt. Dependent claim 30 additionally recites that the first and second engagement element comprise lugs on the finish and the closure skirt respectively. Dependent claim 31 additionally recites that the third and fourth engagement elements comprise threads on the container finish and the closure skirt respectively. Dependent claim 32 recites that the portion of the skirt, on which the second engagement element is disposed, is frangibly connected to the remainder of the closure shell. The adapter ring in Mathes clearly is not "frangibly" connected to the closure skirt, bearing in mind that "frangible" is defined as "readily or easily broken" in *Webster's Ninth New Collegiate Dictionary* for example. The cited references do not disclose or suggest the subject matter of these claims.

New independent claim 33 is directed to a method of converting a child-resistant package to a non-child-resistant mode of operation. None of the prior art references cited by the Examiner discloses or even relates to conversion of a child-resistant package to non-child-resistant operation. In accordance with new claim 33, a child-resistant package is provided that includes a container having a finish with a first engagement element, and a closure on the finish having a shell of one-piece integrally molded plastic construction with a skirt having a second engagement element engagable with the first engagement element in a child-resistant mode of operation. The closure is removed in its entirety from the container finish. With the closure shell so removed, a portion of the closure skirt on which the second engagement element is disposed is permanently removed from the closure skirt, and the closure thereby is permanently converted for non-child-resistant mounting on the container. As already noted in detail above, Mathes fails to disclose such a method of converting a package to non-child-resistant operation, either alone or combined with Valyi or Stahl.

New dependent claim 34 recites that the closure shell has a base wall, a first skirt portion adjacent to the base wall and a second skirt portion remote from the base wall "frangibly connected" to the first skirt portion and on which the second engagement element is disposed. Once again, the prior art is completely lacking any such disclosure. New claims 35-37 are patterned after new dependent claims 29-31 discussed above.

It therefore is believed and respectfully submitted that all claims 28-37 remaining in the application are allowable at this time, and favorable action is respectfully solicited.

Please charge any fees associated with this submission to Account No. 15-0875 (Owens-Illinois).

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